

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KASPAR KUSTER and ANTON RUEGGE

Appeal No. 1997-0091
Application No. 08/115,530

ON BRIEF

Before CALVERT, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2, 4, 5, 9 and 14-17.¹ Claims 6, 7 and 10-13 have been objected to as depending from a non-allowed claim. Claims 1, 3 and 8 have been canceled.

We REVERSE.

¹ Claim 17 was amended subsequent to the final rejection.

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BACKGROUND

The appellants' invention relates to an apparatus for coating board-shaped articles, especially printed circuit boards (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bosher 1982	4,324,052	Apr. 13,
Bossard et al. 24, 1985 (Bossard)	4,559,896	Dec.
Wenger et al. 1990 (Wenger)	4,926,789	May 22,
Kuster ²	EP 0 541 879 A1	May 19, 1993

Claims 2, 4, 5, 9 and 14-17 stand rejected under 35
U.S.C.

² In determining the teachings of Kuster, we will rely on the translation provided by the PTO. A copy of the translation is attached for the appellants' convenience.

§ 103 as being unpatentable over Wenger in view of Boshier, Kuster and Bossard.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 18, mailed April 30, 1996) and the response to the appellants' reply brief (Paper No. 20, mailed July 30, 1996) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 17, filed February 12, 1996) and reply brief (Paper No. 19, filed June 27, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness

with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 2, 4, 5, 9 and 14-17 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting **evidence**³ that would

³ Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, (continued...)

have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue (brief, pp. 5-6) that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal recite an apparatus for coating printed circuit boards comprising, inter alia, a coating station having coating means including a pouring table, a vapor-removal and air drying station having a vapor-removal drier, and an air processing module which is arranged in a housing which adjoins an entrance side of the housing of the vapor-removal drier and extends over and above the pouring

³(...continued)
1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

table. However, these limitations are not suggested by the applied prior art. In that regard, none of the applied prior art teaches or suggests an air processing module which is arranged in a housing which adjoins an entrance side of the housing of the vapor-removal drier and extends over and above the pouring table. To supply this omission in the teachings of the applied prior art, the examiner made a determination (answer, pp. 4-10) that this difference would have been obvious to an artisan since the location of the air processing module would have been an obvious choice of engineering design. However, this determination has not been supported by any **evidence** that would have led an artisan to arrive at the claimed invention. In that regard, the examiner has not applied any evidence that would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have arranged the air processing module in a housing which adjoins an entrance side of the housing of the vapor-removal drier and extends over and above the pouring table.

In our view, the only suggestion for modifying the applied prior art in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C.

§ 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 2, 4, 5, 9 and 14-17.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2, 4, 5, 9 and 14-17 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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